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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,592	02/23/2004	Reinhard Wilting	10406.203-US	1369

25908 7590 06/12/2006

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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/784,592

Applicant(s)

WILTING ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 36-40 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 36-40 are currently pending in this application.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36-40 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Claims 36-40 are drawn to a polypeptide comprising an amino acid sequence which has at least 90% identity with an amino acid sequence comprising amino acids 42-248 of SEQ ID NO:43 or which is encoded by a nucleotide sequence which hybridize under high stringency conditions with the complementary strand of a nucleotide sequence comprising nucleotides 124-744 of SEQ ID NO:18.

The applicant has asserted the above polypeptide as a "functional polypeptide" in the specification meaning that a polypeptide which can be expressed and secreted by a cell and which constitutes an operational unit capable of operating in accordance with the function it is designed to fulfill by the cell and optionally, co-factors may be required for the polypeptide to adopt the intended function. One example the applicant provides for "functional polypeptide",

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but not necessarily the actual function of the SEQ ID NO:43 is catalytically active polypeptides or enzymes which help the cell catalyzing reactions in the environment surrounding the cell.

Another example is that of polypeptides which serve as signal substance. polypeptides which function as sensors (receptors) for environmental parameters (chemicals in the environment surrounding the cell) or polypeptides, which are active against other organisms (antimicrobial (polypeptides) or polypeptides, which contributes to the structural integrity of the cell. (see page 6-7). However none of these functions are by themselves specific or specific to SEQ ID NO:43. Furthermore, but for a generalized function of a polypeptide in a cell the above definition makes no scientific sense with respect to the function of SEQ ID NO:43 for one of ordinary skill in the art. Examiner takes the position that such asserted utility is not specific and substantial. The broadly claimed polypeptides and its fragments are based on SEQ ID NO:43, a polypeptide isolated from a Bacilli, the specification provides little functional characterization of this protein or key roles in regulation of any cell cycle events. While the specification lists generalized properties of "functional polypeptides", there is no information that links the use of the polypeptide with SEQ ID NO:43 to any specific activity/function. Thus the asserted utility of the claimed polypeptides and its fragments is not substantial or specific.

Claims 36-40 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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Applicant is referred to the revised interim guidelines concerning compliance with utility requirement of U.S.C. 101, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

Claims 36-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a polypeptide with SEQ ID NO:43, does not reasonably provide enablement for any polypeptide comprising an amino acid having 90% or 95% identity to SEQ ID NO: 43 or for a polypeptide encoded by a polynucleotide that can hybridize with SEQ ID NO:18 under high or very high stringency conditions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claims 36-40 are so broad as to encompass any polypeptide comprising an amino acid having 90% or 95% identity to SEQ ID NO: 43 or for a polypeptide encoded by a polynucleotide that can hybridize with SEQ ID NO:18 under high or very high stringency conditions. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of polypeptides broadly encompassed by the claims. Since the

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amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a knowledge of and guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the proteins' structure relates to its function. However, in this case the disclosure is limited to the amino acid sequence of SEQ ID NO:43 with unknown functions. It would require undue experimentation of the skilled artisan to 1) make the polypeptides as claimed and 2) use the claimed polypeptides for any gainful purpose. The specification provides no guidance with regard to the making of variants and mutants or with regard to uses. In view of the great breadth of the claim, amount of experimentation required to make the claimed polypeptides and use the polypeptides, the lack of guidance, working examples, and unpredictability of the art in predicting function from a polypeptide primary structure (e.g., see Ngo et al. in *The Protein Folding Problem and Tertiary Structure Prediction*, 1994, Merz et al. (ed.), Birkhauser, Boston, MA, pp. 433 and 492-495), the claimed invention would require undue experimentation. As such, the specification fails to teach one of ordinary skill how to make and use the full scope of the polypeptides encompassed by this claim.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including polypeptides with an enormous number of amino acid modifications SEQ ID NOS43 whose activity itself is unknown. The scope of the claims must bear a reasonable correlation with the scope of enablement (*In re Fisher*, 166 USPQ 19 24

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(CCPA 1970)). Without sufficient guidance, the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988).

Claims 36-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 36-40 are directed to polypeptide SEQ ID NO:43 and variants of SEQ ID NO:43. Claims 36-40 are rejected under this section of 35 USC 112 because the claims are directed to a genus of polypeptides such as SEQ ID NO:43 and those that are derived from SEQ ID NO:43 including modified polypeptide sequences, modified by at least one of deletion, addition, insertion and substitution of an amino acid residue in SEQ ID NO:43 and fragments of SEQ ID NO:43 that have not been disclosed in the specification. No description has been provided of the modified all sequences encompassed by the claim. No information, has been provided by applicants which would indicate that they had possession of the claimed genus of polypeptides. The specification does not contain any disclosure of the function of all the polypeptide sequences, including fragments and variants within the scope of the claimed genus. The genus of polypeptides claimed is a large variable genus including peptides which can have a wide variety of functions and with the potentiality of generating many different antibodies. Therefore many functionally unrelated polypeptides are encompassed within the scope of these claims. The specification discloses only a single species of the claimed genus which is insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that applicant had possession of the claimed invention at the time the instant application was filed.

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Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

***Conclusion***

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.  
Primary Examiner  
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May 31, 2006